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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,888	04/06/2001	Hisashi Hotta	003510-091	3377

7590

07/01/2003

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,888

Applicant(s)

HOTTA, HISASHI

Examiner

Cynthia Hamilton

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 09 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The examiner notes applicants have not submitted a marked up copy of the amended claims. Since a full copy of the claims was not submitted, i.e. no copy of claims 18-21 was part of the claims submitted by amendment, the amendment submitted does not conform with the optional practice, applicants did not file an amendment which follows the requirements for the Amendments in a revised formant now permitted signed January 31, 2003. The examiner waves the need for this markup copy because the amendments are minimal. However, applicants are warned that the amendments may retain the markouts and underlines presented in the amendment. The examiner suggests applicants submit a clean copy of all of these amendments and claims in response to this action to avoid any possible problems if this applicant issues as a patent.

2. The corrected or substitute drawings were received on April 9, 2003. These drawings are approved by the examiner.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In Figure 2, the reference signs not mentioned are 19, 11, 17, 14, 22b, 22a, and 12. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The amendment filed April 9, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

Art Unit: 1752

supported by the original disclosure is as follows: The paragraph added by applicants on page 35, between lines 16-17. Applicants have not shown where the support for this addition is. The terms with the numbers which are derived from Figure 2 are not new matter, but the process around the terms is not clearly supported by the specification. Thus, W is aluminum but there is no support given for making W a plate. It is not clear that a plate winds through slit 16 from the picture. It is not clear from Figure 2 that electrolyte 15 flows through a space between the auxiliary anode 23 and the aluminum plate W and drains into an electrolyte discharge port 18.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The examiner suggests that to remove these objections because of the presence of Figure 2 that applicants cancel the amendment to page 35 and replace it with a list of terms and numbers from Figure 2. Any added explanation with these numbers needs to flow from the Figure or come from some support in the original specification. The other alternative is to strip the specification and Figure 2 of all reference to numbers. This would leave Figure 2 with only word descriptions and it would remove the problem of adding words to the specification. The final alternative is to remove Figure 2 and all reference to it in this application.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

Art Unit: 1752

the invention. Applicants have amended claim 2 to include "after a development process" and "physically" between "micropores" and "exposed". This amendment does not remove the confusion as to what is being claimed here. In claim 2, (ii), the property set forth is confusing because the plate claimed is a recording layer writeable by laser exposure but the property of a contact angle of "a non-image area" after a developing process is directed to a different plate, i.e. the plate after non-specified development steps. Because there is no process relationship between the plate claimed and the intended plate of (ii), the properties set forth are not clearly linked to any formation on the plate claimed. Thus, it is not clear how the plate that is imageable becomes the plate imaged with the required contact angle and micropore properties. It cannot be determined if such properties can occur because of process steps occurring after the plate is imaged and developed such as filling in micropores with after coat materials. Thus, it is not clear if the properties of (ii) are limited to intended use or are actual limits that result from the imageable plate. Applicants on page 15 of their specification reference (ii) as being a condition of controlling vacancy ratio and distribution density to thereby optimize the anodic oxidation condition, it may be further possible to treat the anodic oxidation coating with an aqueous solution of acids or alkalies in order to increase vacancy ratio. On page 16, a sealing process can be used to control the surface area and /or vacancy ration of the support after forming of the anodic oxide coating. There are more methods for this control in the pages following. It is not clear from the current claim language that the physical characteristics of the unimaged plate are those which govern the final intended conditions set forth in (ii). Thus, claims 2-21 are held confusing.

Art Unit: 1752

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

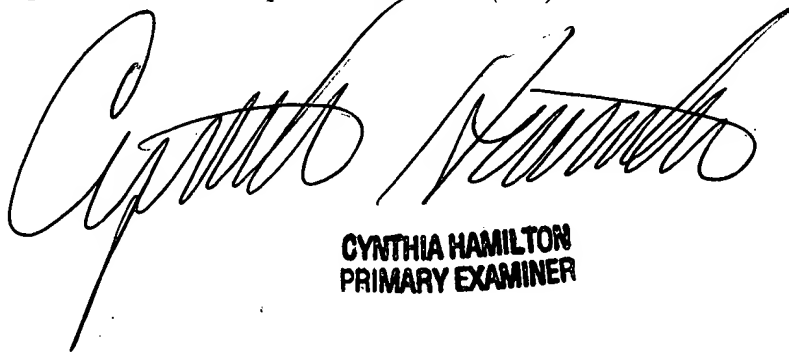
10. Claim 1 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the 1700 receptionist whose telephone number is (703) 308-0661.

Cynthia Hamilton
June 30, 2003



**CYNTHIA HAMILTON
PRIMARY EXAMINER**